

REMARKS/ARGUMENTS

Reconsideration of this application and entry of the foregoing amendments are respectfully requested.

The claims have been revised to define the invention with additional clarity. Specifically, claim 1 has been amended so as to be drawn to a method of screening a test mammal for cancer and to make explicit that which is believed to be implicit in the term "control". Further, claim 1 has been revised to indicate that the biological sample is a serum sample and to avoid the use of the term "tumor". Claim 6 has been revised to indicate that the test mammal is one suspected of having prostate cancer. In addition to claim 7, claims 2 and 3 have been cancelled without prejudice. That claims have been revised/cancelled should not be taken as an indication that Applicants agree with any view expressed by the Examiner. Rather, the revisions have been made merely to advance prosecution and Applicants reserve the right to pursue any deleted subject matter in a continuation application.

The Examiner requests that the specification be amended to reflect the status of the parent application. The parent of the present case is Provisional Application No. 60/250,159, filed December 1, 2000. Given the provisional nature of the parent case, there can be no ambiguity as to its status and thus no amendment of the specification is believed to be necessary.

Claims 1-7 stand rejected under 35 USC 112, first paragraph, as allegedly being non-enabled. Withdrawal of the rejection is submitted to be in order in view of the above-noted claim amendments and comments that follow.

In item 6 of the Office Action, the Examiner makes reference to the overexpression of ZAG associated with cachexia and contends that it is not possible to "diagnose" a specific disease based on ZAG concentrations. In so contending, the Examiner appears to be interpreting

the term "diagnosing" as "definitively diagnosing". While in no way agreeing with this interpretation, claim 1 has been revised to more clearly indicate that the instant invention is a screening method, that is a method that can be used to identify a test mammal that is at an increased likelihood of having cancer. This approach is similar in nature to the well known prostate cancer screening method based on elevated levels of PSA. As the Examiner doubtless appreciates, while an elevated PSA level does not provide the definitive diagnosis of cancer provided by a biopsy, it nonetheless represents an invaluable diagnostic tool – likewise, the method of the instant claims.

The concern expressed by the Examiner in paragraph 7 of the Office Action appears based on the fact that Examiner broadly interprets the term "control" as encompassing unmatched samples. While Applicants do not agree with the Examiner's position in this regard, claim 1 has been revised in a manner that is believed to address the Examiner's concern.

The above-noted amendment of claim 6 and cancellation of claim 7 is believed to address the concern expressed by the Examiner in paragraph 8 of the Office Action.

Reconsideration is requested.

Claims 1-7 stand rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Withdrawal of the rejection is submitted to be in order in view of the above-noted claim revisions. Reconsideration is requested.

Claims 1, 4 and 5 stand rejected under 35 USC 102(b) as allegedly being anticipated by Bundred et al. Withdrawal of the rejection is submitted to be in order in view of the above-noted revision of claim 1 so as to define the biological sample as a serum sample. Reconsideration is requested.

HALE et al
Appl. No. 09/998,923
January 24, 2005

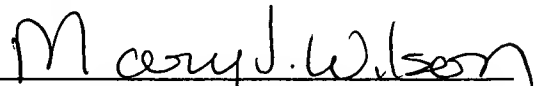
Claims 1-3 stand rejected under 35 USC 102(b) as allegedly being anticipated by Lopez-Ortin et al. Withdrawal of the rejection is submitted to be in order in view of the above-noted revision of claim 1 so as to define the biological sample as a serum sample. Reconsideration is requested.

This application is submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



Mary J. Wilson
Reg. No. 32,955

MJW:tat
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100